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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------------------|-----------------------------|
| 10/566,404 | 09/07/2006 | Antoni Torrens Jover | 284362US0PCT | 3482 |
| 22850 | 7590 | 01/25/2010 | | |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | EXAMINER MCDOWELL, BRIAN E | |
| | | | ART UNIT 1624 | PAPER NUMBER |
| | | | NOTIFICATION DATE 01/25/2010 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/566,404 | Applicant(s) TORRENS JOVER ET AL. | |
| | Examiner BRIAN MCDOWELL | Art Unit 1624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 and 58-74 is/are pending in the application.
- 4a) Of the above claim(s) 15-17, 20-41, 58-60, 64-66 and 68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 18, 19, 42-56, 61-63, 67, 69-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

/BEM/

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/23/2009 has been entered.

Priority

This application claims the priority date of 7/30/2003. However, since claim 70 was amended to include a proviso which did not have support in the foreign application disclosure; the instant application receives the effective priority date of 7/29/2004.

Status of Claims

Claims 1-56 and 58-74 are pending in the instant application. Claims 15-17, 20-41, 58-60, 64-66, and 68 are withdrawn from consideration.

An action on the merits of claims 1-14, 18, 19, 42-56, 61-63, 67, and 69-74 is contained herein.

Status of Claim Objections

Applicant's amendments, see Remarks, filed 12/23/2009, with respect to the objection set forth in the Final Office Action mailed 7/24/2009, have been fully considered and the objection has been overcome.

Status of Rejections

35 USC § 112 (2nd Paragraph)

Applicant's amendment, see Remarks, filed 12/23/2009, with respect to the rejection set forth in the Final Office Action mailed 7/24/2009, has been fully considered and the rejection has been overcome.

35 USC § 102

Applicant's amendment, see Remarks, filed 12/23/2009, with respect to the rejection set forth in the Final Office Action mailed 7/24/2009, has been fully considered and the rejection has been overcome.

New Objections and Rejections

Claim Objections

Claims 19, 62, and 63, objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. **The "for use"**

limitations introduced into the claims do not further limit the subject matter in the claims where they occur and the claims should be deleted as duplicates or amended to further limit the pharmaceutical composition claims. Appropriate correction is required.

Claims 1-14, 18, 19, 42-56, 61-63, 67, and 69-74 are objected to for the following reason:

Generic claim 70 and subsequent dependent claims are drawn to compounds of the formula I and "corresponding salts thereof." The instant claims should be drawn to "pharmaceutically acceptable salts thereof" since the claimed compounds are expected to be utilized in a pharmaceutical environment. Appropriate correction is required.

Claim Rejections - 35 USC § 112 (2nd Paragraph)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14, 18, 19, 42-56, 61-63, 67, and 69-74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-14, 18, 19, 42-56, 61-63, 67, and 69-74 are indefinite for containing a broad and a narrow limitation in the same claim. For example, in the instant claims, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In claim 70, applicant recites the limitation wherein "R¹⁰ may be condensed with a mono- or polycyclic ring system, then recites limitations for said substituent wherein "R¹⁰ may be condensed with an optionally at least mono-substituted aryl- or heteroaryl radical ", which is the narrower statement of the range/limitation. The same analysis is applied towards substituents R¹¹⁻¹⁴, etc. Please amend appropriately throughout.

Claim 69 is indefinite because said claim cites that substituents such as "dimethylamino", phenyl, 1-naphthyl, etc." may serve as "*alkyl radicals*". Alkyl radicals are construed to one of ordinary skill as branched or unbranched carbon chains and not cyclic structures. The examiner can not interpret the metes and bounds of this claim in view of this description which does not comply with conventional meaning of "alkyl".

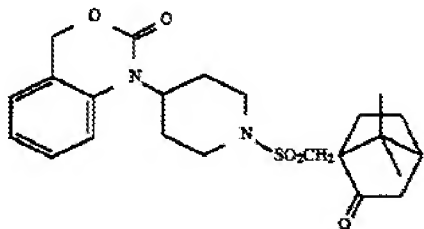
Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-13, 18, 19, 42-45, 47-55, 61-63, 70, 72, and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bock *et al.* (US Patent 5,665,719-mentioned in international search report).

Bock *et al.* teach the following compound (see col. 30, example 10, and previous office actions):



wherein $R^{1-9} = H$ and $W =$ a substituted cycloaliphatic radical bonded via a methylene group. The document further mentions that this compound may be used to treat hypertension (see col. 270, claim 16); a common food-intake related disorder.

The aforementioned claims may encompass an analogous compound with the exception that the substituted cycloaliphatic radical is bonded via an *ethylene* group.

Both compounds possess the same utility (used to treat food-intake disorders) and are considered homologs to one of ordinary skill. MPEP 2144.09 states the following in reference to the latter:

Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH₂- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. In re Wilder, 563 F.2d 457, 195 USPQ 426 (CCPA 1977).

Based on the above statement, one of ordinary skill would have a reasonable expectation of success in making a homolog of the compound described by Bock and subsequently expect to obtain a compound with comparable biological activity to the prior art compound. Therefore, the claimed compounds are obvious.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN MCDOWELL whose telephone number is (571)270-5755. The examiner can normally be reached on Monday-Thursday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached 571-272-0661. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. E. M./
Examiner, Art Unit 1624

**/James O. Wilson/
Supervisory Patent Examiner, AU 1624**